

REMARKS/ARGUMENTS

This is a preliminary amendment in a RCE Application. The Office Action mailed March 29, 2004 has been carefully reviewed. The claims presented for examination are claims 1–8. Applicants respectfully request reconsideration of this application as amended and in view of the following remarks.

35 USC 112 Rejection

Claims 2, 4, and 8 were rejected as indefinite because the term "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. Applicants have amended claims 2, 4, and 8 to remove the term "such as."

Claims 6-7 were rejected as indefinite with the comment that "It is not clear as how and why the applied optical coating transmits ASE and parasitic light into the optical coating as claimed." Applicants have amended claims 6-8 to clarify that the "outside material coating layer will scatter and absorb amplified spontaneous emission and parasitic light that reaches said outside material coating layer so as to prevent it from re-entering said laser gain element."

Claims 6-7 were objected to because of the use of the term "designed." Applicants have amended claims 6-7 to remove the term "designed."

35 U.S.C. 102 Rejection

In the Office Action mailed March 29, 2004, Claims 1-2 and 6-8 were rejected under 35 U.S.C. 102(b) as allegedly being anticipated by the Zapata reference (U.S. Patent No. 5,335,237).

Applicant has amended claims 1-2 and 6-8 presented for examination; therefore claims 1-2 and 6-8 are now presented in amended form. Since claims 1-2 and 6-8 now appear in amended form the 35 USC §102 rejection in the Office Action mailed March 29, 2004 no longer applies.

Applicant believes the invention claimed in claims 1-2 and 6-8 is not anticipated by the Zapata reference. The standard for a 35 USC §102 rejection is stated in Verdegaal Bros. v. Union Oil Co of California, 814 F.2nd 628, 631 USPQ 1051, 1053 (Fed. Cir. 1987), "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference." Applicant points out that the following elements of amended claims 1-2 and 6-8 are not found in the Zapata reference:

"said layered coating comprising a reflective inner material coating layer and an absorptive and scattering outside material coating layer and

configured to substantially reflect the pump light that strikes the layered coating so as to direct the pump light back into said laser gain medium, and

substantially transmit said amplified spontaneous emission and/or parasitic light that strikes the layered coating so as to let this light strike said outside material coating layer of said layered coating where it is scattered and absorbed."

In the Zapata reference, "the Medium M2 is a multilayer metal-dielectric absorbing coating." (Col 4, lines 23-24) The Zapata reference does not show an "absorptive and scattering" outside material coating layer.

Since the elements described above are not found in the Zapata reference, the Zapata reference would not support a 35 USC §102 rejection.

35 U.S.C. 103 Rejection – Zapata and Kawamura et al

In the Office Action mailed March 29, 2004, claim 3 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the Zapata reference in view of the Kawamura et al reference (U.S. 5,856,060).

Applicant has amended claim 3; therefore claim 3 is now presented in amended form. Since claim 3 now appears in amended form the 35 USC §103(a) rejection in the Office Action mailed March 29, 2004 no longer applies.

Applicants believe that claim 3 is patentable and that the Zapata and Kawamura et al references would not support a 35 USC §103(a) rejection. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include "Ascertaining the differences between the prior art and the claims at issue."

The differences between the primary Zapata reference and Applicants' invention defined by amended claim 3 includes the fact that the following elements of amended claim 3 is not found in the primary Zapata reference:

"said layered coating comprising a reflective inner material coating layer and an absorptive and scattering outside material coating layer and

configured to substantially reflect the pump light that strikes the layered coating so as to direct the pump light back into said laser gain medium, and

substantially transmit said amplified spontaneous emission and/or parasitic light that strikes the layered coating so as to let this light strike said outside material coating layer of said layered coating where it is scattered and absorbed."

The Kawamura et al reference also fails to show the elements of claim 3 identified above. Since both references fail to show the elements, there can be no combination of the two references that would show Applicant's invention defined by amended claim 3 and render it unpatentable. There is no combination of the Zapata reference and the Kawamura et al reference that would produce the combination of elements of Applicants' amended claim 3. Further, there is no teaching of combining the Zapata reference and the Kawamura et al reference to meet Applicants' amended claim 3. Thus, the combination of references fails to support a rejection of the claims under 35 USC 103, and the rejection should be withdrawn.

35 U.S.C. 103 Rejection – Zapata and Ragle et al

In the Office Action mailed March 29, 2004, claim 5 was rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over the Zapata reference in view of the Ragle et al reference (U.S. 4,891,815).

Applicant has amended claim 5; therefore claim 5 is now presented in amended form. Since claim 5 now appears in amended form the 35 USC §103(a) rejection in the Office Action mailed March 29, 2004 no longer applies.

Applicants believe that claim 5 is patentable and that the Zapata and Ragle et al references would not support a 35 USC §103(a) rejection. The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966) that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) include "Ascertaining the differences between the prior art and the claims at issue."

The differences between the primary Zapata reference and Applicants' invention defined by amended claim 5 includes the fact that the following elements of amended claim 5 is not found in the primary Zapata reference:

"said layered coating comprising a reflective inner material coating layer and an absorptive and scattering outside material coating layer and

configured to substantially reflect the pump light that strikes the layered coating so as to direct the pump light back into said laser gain medium, and

substantially transmit said amplified spontaneous emission and/or parasitic light that strikes the layered coating so as to let this light strike said outside material coating layer of said layered coating where it is scattered and absorbed."

The Ragle et al reference also fails to show the elements of claim 5 identified above. Since both references fail to show the elements, there can be no combination of the two references that would show Applicant's invention defined by amended claim 5 and render it unpatentable. There is no combination of the Zapata reference and the Ragle et al reference that would produce the combination of elements of Applicants'

amended claim 5. Further, there is no teaching of combining the Zapata reference and the Ragle et al reference to meet Applicants' amended claim 5. Thus, the combination of references fails to support a rejection of the claims under 35 USC 103, and the rejection should be withdrawn.

SUMMARY

The undersigned respectfully submits that, in view of the amendments and the foregoing remarks, the rejections of the claims raised in the Office Action dated March 29, 2004 have been fully addressed and overcome, and the present application is believed to be in condition for allowance. It is respectfully requested that this application be reconsidered, that the claims be allowed, and that this case be passed to issue. If it is believed that a telephone conversation would expedite the prosecution of the present application, or clarify matters with regard to its allowance, the Examiner is invited to call the undersigned attorney at (925) 424-6897.

Respectfully submitted,



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